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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,580	01/23/2004	John Carney	40004572-0023-002	7727
26263 7590 12/24/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
PARRA, OMAR S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,580

Applicant(s)

CARNEY ET AL.

Examiner

OMAR PARRA

Art Unit

2421

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-13, 15-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-13, 15-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/09/2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) **1, 2 and 4-11** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Response to Arguments

3. Applicant's arguments filed 10/09/2008 have been fully considered but they are not persuasive.

In response to applicant's remarks:

Applicant argues that *"Neither of these references [Begeja and Holtz] teaches or suggests automatically creating a composite VOD clip to include one or more corresponding VOD clips from each of selected ones of VOD clip categories assembled according to selected VOD clip parameters of each selected VOD clip category"*, page 10 lines 5-8. To this matter, the examiner respectfully disagrees.

Holtz teaches a system that collects video clips from different sources about a user-specified topic, puts them together as a single program and sends it to the user for viewing (Abstract; col. 16 line 3- col. 17 line 5). Holtz also teaches that the user is able to specify the topic of the video clips from a general topic down to 2 or 3 levels of specificity (i.e. a topic, a category within a topic, a sub-category within a category, col. 13 lines 3-39; col. 17 lines 1-5; col. 31 lines 27-56). The user is provided with a drop-down menu (listing) or a sequence of dialog boxes (e.g. wizard) to narrow his/hers selection topic. The user is able to select the duration of the video to any desired length, as part of the video parameters.

Applicant also argues that *"the VOD clip parameters do not define how individual ones of the VOD clips from selected VOD clip categories will be assembled into the composite VOD clip and instead relate to the subject VOD clip"*, page 10 lines 16-18. To this matter, the examiner respectfully disagrees.

Holtz teaches that the user can select different video parameters (Abstract; col. 16 line 3- col. 17 line 5; col. 13 lines 3-39; col. 17 lines 1-5; col. 31 lines 27-56) such as category, duration of the video, etc. By specifying the length of the video, the number of segments is affected. In other words, the higher the length of the video, the higher the number of segments include, and vice versa. In other words, this selection affects how the individual ones of the VOD clips will be assembled into the composite video clip.

Additionally to the previous analysis, Holtz also explicitly teach that the number of video segments can also be selected (col. 16 lines 42-45).

Therefore, the examiner respectfully believes that the references of record still cover applicant's invention as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1, 2, 4-13, 15-23 and 26-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Begeja et al. (hereinafter 'Begeja', Pub. No. US 2003/0030752) in view of Holtz et al. (hereinafter 'Holtz', Patent No. 6,760,916).

Regarding claims 1, 12 and 22, Begeja teaches a system (with corresponding method and computer-readable medium) comprising:

a server (“**Video Server**”, 220 Fig.2, or “**Video Storage**”, 210 Fig.2, if more storage is needed) storing VOD content ([0031] lines 1-2), the VOD content including defined by a plurality of VOD clip categories ([0051] lines 3-4),, each VOD clip category containing one or more corresponding ones of the VOD clips ([0051] lines 4-5); and

a set top box (370, Fig.3) communicatively coupled to the server (220, Fig.3), the set top box storing an application ([0058] lines 4-5 or [0015] paragraph-lines 2-5 of incorporated by reference application, Begeja Pub. No. 2003/0163815), the application configured to provide a user with a VOD clip category selection functionality ([0054] lines 3-4; [0051] lines 3-4) that enables the user to select from among the plurality of VOD clip categories and a VOD clip parameter selection functionality (**Buttons, Drop-down menus and check boxes, Fig. 4-5**) (; and

a VOD clip composite functionality configured to automatically create the composite VOD clip to include one or more corresponding VOD clips from each of the selected VOD clip categories assembled according to the selected VOD clip parameters of each selected VOD clip category ([0028] ¶ lines 1-3; [0059] lines 9-10 or see 405, Fig.4).

On the other hand, Begeja does not explicitly teach the selection of the VOD parameters defining how individual ones of the VOD clips from selected ones of the VOD clip categories will be assembled into a composite VOD clip.

However, in an analogous art, Holtz teaches a VOD multimedia production and distribution system that assembles a media production from a variety of sources based on personal preferences (Abstract). Holtz teaches that for setting the user preferences

or the type of content he/she wants, a VOD clips attribute selection functionality is presented to him/her in order to let the system know what categories are desired, how long he/she wants the production or clips to be, etc (col. 13 lines 3-31; col. 16 line 4-col. 17 line 5; col. 31 line 18-col. 32 line 64). By specifying the length of the video, the number of segments is affected. In other words, the higher the length of the video is, the higher the number of segments included, and vice versa. In other words, this selection affects how the individual ones of the VOD clips will be assembled into the composite video clip. Holtz also explicitly teach that the number of video segments can also be selected (col. 16 lines 42-45).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Begeja's invention with Holtz's feature of letting the user to define video clips attributes through an interface for the benefit of providing to the user a neat, easy to fill up interface for customizing the video clips or content to be received.

Regarding claims 2, 13, and 23, Begeja and Holtz teach presenting the composite VOD clip to a user to effect a passive viewing experience ([0053] lines 19-20).

Regarding claims 4 and 15, Begeja and Holtz teach wherein the composite VOD clip consists of a subset of the one or more VOD clips corresponding to the selected VOD clip parameters in each selected VOD clip category (565, Fig. 5).

Regarding claims 5, 16 and 25, Begeja and Holtz teach wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (**420, Fig.4, “Play all clips” without knowing what’s going to play is a random selection**), a maximum number parameter, a maximum time parameter, and a sequential parameter (**[0065] lines 2-4**) .

Regarding claims 6, 17 and 26, Begeja and Holtz teach wherein the composite VOD clip is automatically regenerated (**[0026] lines 7-10**) upon user request (“**instant search**”, **[0058], paragraph-line 2**) or according to an externally specified schedule (“**...on a periodic basis...**”**[0026], line 9**).

Regarding claims 7, 18 and 27, Begeja and Holtz teach wherein one or more VOD clips made available prior to a specified time (**405, Fig.4, videos are available prior user’s selection**) are removed from the composite VOD clip (“**AT&T, 8 clips**”, “**Jay Lenos White H... 10 clips**”, “**Sports, 6 clips**”, see **Fig.4**, are removed after choosing “**Politics**”; **505, Fig. 5**).

Regarding claims 8, 19 and 28, Begeja and Holtz teach wherein one or more corresponding VOD clips previously presented to a user (**405, Fig.4, videos are available prior user’s selection**) are removed from the composite VOD clip (“**AT&T, 8**

clips”, “Jay Lenos White H... 10 clips”, “Sports, 6 clips”, see Fig.4, are removed after choosing “Politics”; 505, Fig. 5).

Regarding claims 9, 20 and 29, Begeja and Holtz teach wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip **(“The user can add a new topic using button 425, Fig.4” [0062] paragraph line 3, which inherently would add more clips to the composite video).**

Regarding claims 10, 21 and 30, Begeja and Holtz teach wherein the one or more additional VOD clips comprise VOD clips are selected from the group consisting of advertising VOD clips **([0057] lines 19-21)**, promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip **(“Additional marketing and advertising (such as a commercial...)”, [0057] paragraph lines 19-20)**, and promotional VOD clips pertaining to VOD content related to the composite VOD clip **(“Relevant information that might be embedded into a media stream being delivered...might include...information about the subject matter of the stream or related thereto, such as advertising...”**, [0087] paragraph lines 1-4).

Regarding claim 11, Begeja and Holtz teach a method wherein one or more additional graphical or data contents, including content tickers, graphical ads or promotional contents unrelated to the composite VOD clip, and content tickers, graphical ads or promotional contents related to the composite VOD clip **([0087]**

paragraph lines 5-7 or also, 555, Fig.5) are added alongside or partially overlay the composite VOD clip.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP

/Hunter B. Lonsberry/
Primary Examiner, Art Unit 2421